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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/785,793	02/16/2001	Bertrand Seraphin	11621-004-999	5538
20583	7590	01/12/2007		
JONES DAY 222 EAST 41ST ST NEW YORK, NY 10017			EXAMINER HINES, JANA A	
			ART UNIT	PAPER NUMBER
			1645	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
30 DAYS		01/12/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/785,793

Applicant(s)

SERAPHIN ET AL.

Examiner

Ja-Na Hines

Art Unit

1645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 29-54 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

NON-RESPONSIVE AMENDMENT

1. The communication filed on October 18, 2006 is not responsive to the communication mailed previously.

The amendment filed on October 18, 2006 cancelled all claims drawn to the elected invention and presented claims drawn to a new non-elected invention is non-responsive (MPEP § 821.03). Thus the response is non-responsive. New claims 29-54 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

The previous claims were drawn to a method for purifying biomolecules and/or protein complexes, the method comprising: (a) providing an expression environment containing one or more heterologous nucleic acids encoding one or more subunits of a biomolecule complex; (b) maintaining the expression environment under conditions that facilitate expression of the one or more subunits in a native form as fusion proteins with subunits being fused to at least two different affinity tags, wherein one of the affinity tags consists of one or more IgG binding domains of Staphylococcus protein A; and (c) purifying the one or more subunits by a combinations of at least two different affinity purification steps each comprising binding the one or more subunits via one affinity tag to a support material capable of selectively binding one of the affinity tags and separating the one or more subunits from the support material after substances not bound to the support material have been removed to provide a purified biomolecule and/or protein complex.

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Now the invention is drawn to a method for purifying a polypeptide of interest, or a biomolecule complex comprising the polypeptide of interest, said method comprising:

a) providing a eukaryotic expression environment such that a fusion protein is expressed under conditions that allow formation of a complex between the fusion protein and one or more other biomolecules; said fusion protein comprising said polypeptide and at least two different affinity tags; and b) purifying said polypeptide, or any said complex that forms, by performing combination of at least two different affinity purification steps, each comprising binding the fusion protein, or a truncated fusion proteins wherein one of the affinity tags is cleaved off, via one affinity tag to a support material capable of selectively binding one of the affinity tags, and separating the fusion protein or the truncated fusion protein or the polypeptide from the support material after substances not bound to the support material have been removed, wherein any of said one or more other biomolecules which are bound to said polypeptide in any said complex remain associated with said polypeptide during said step (b), thereby purifying said polypeptide of interest or biomolecule complex comprising said polypeptide of interest.

The new added claims are not readable on the elected invention because the new invention is drawn to an entirely different method, i.e., the new method provides for the expression of a materially different product as compared to the originally expressed product. The new expression product is fusion protein comprising said polypeptide and at least two different affinity tags complexed to one or more other biomolecules. This is a materially different product, thus the fusion proteins are materially different. Also the

new method claims are drawn to a materially different expression environment. The new claims are also drawn to the employing a truncated fusion protein. There is no correlation between the previous claims and the newly submitted claims. The previous method claims are not drawn to the same outcome.

Furthermore, the original Election/Restriction dated September 4, 2002 separated methods drawn to the detection and/or purification of substances capable of complexing with fusion proteins. Thus, the examiner cannot appreciate that the new claims would read on the previously claimed invention.

2. Since the above-mentioned amendment appears to be a *bona fide* attempt to reply, applicant is given a TIME PERIOD of ONE (1) MONTH or THIRTY (30) DAYS, whichever is longer, from the mailing date of this notice within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD UNDER 37 CFR 1.136(a) ARE AVAILABLE.

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ja-Na Hines whose telephone number is 571-272-0859. The examiner can normally be reached on Monday-Thursday and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor Jeffery Siew, can be reached on 571-272-0787. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ja-Na Hines

January 3, 2007

